

REMARKS

Claims 1, 7-10, and 12 are amended. Claims 2-6 are canceled. Claims 1 and 7-12 are pending.

Support for Amendments

Claim 1 is amended to include an element of 95% sequence identity. Support can be found for example in original claims 1 and 6. Claims 7-10 are amended in favor of the term “comprising” and according to dependency practice in the US. Claim 12 is amended to correct a typographical error. Support for the amendment to claim 12 can be found in original claims 11 and 12 and throughout the specification, for example at page 7, lines 7-9.

Claim Objections

The Office Action objects to claims 1-7 for the term “hybridising” as an English rather than American spelling. Applicants respectfully traverse. According to the MPEP,

Examiners should not object to the specification and/or claims in patent applications merely because applicants are using British English spellings (e.g., colour) rather than American English spellings. It is not necessary to replace the British English spellings with the equivalent American English spellings in the U.S. patent applications. Note that 37 CFR 1.52(b)(1)(ii) only requires the application to be in the English language. There is no additional requirement that the English must be American English.

(MPEP 608.01). As the MPEP specifically states that such objections should not be made, Applicants respectfully request withdrawal of the objection.

Priority Document

The Office Action requests a certified copy of the priority document. Applicants respectfully traverse. The instant application is the entry of the national phase under 35 USC 371. According to the MPEP,

The requirement in PCT Rule 17 for a certified copy of the foreign priority application is normally fulfilled by applicant providing a certified copy to the receiving Office or to the International Bureau.... The copy of the stamped priority document sent to the U.S. Patent and Trademark Office from the International Bureau is acceptable to establish that applicant has filed a certified copy of the priority document.

(see MPEP 1893.03(c)II). Applicants have met their requirements by submitting a certified copy of the priority document during the international phase (see attached copy of Form PCT/IB/304 "Notification Concerning Submission or Transmittal of Priority Document"). If the USPTO has misplaced its copy of the priority document from the International Bureau, the Examiner may download a copy of the priority document from the WIPO website (<http://www.wipo.int/ipdl/en/>) by entering the international application number (PCT/GB2003/003538) in the search box for the PCT database, and following the link to the "Document" tab, where the Examiner will find a copy of the priority document. For the convenience of the Examiner, Applicants attach a printout of the certified priority document from the WIPO website.

Information Disclosure Statement

Applicants submit herewith an IDS and copy of cited reference.

Rejections Under 35 U.S.C. § 112, 2nd paragraph

Claim 12 is rejected under 35 U.S.C. § 112, 2nd paragraph, for depending from itself. Claim 12 is amended to correct the typographical error. Applicants request withdrawal of the rejection.

Claims 1-8 and 10-12 are rejected for the phrase “stringent conditions” in claim 1. Applicants respectfully traverse. However, in order to advance prosecution, Applicants have removed the phrase from the claims. Applicants respectfully request withdrawal of the rejection.

Claims 2-7 are rejected for the phrase “a frament of fragment of polynucleotides” in claim 1(a). Applicants respectfully traverse. However, in order to advance prosecution, Applicants have removed the phrase from the claims. Applicants respectfully request withdrawal of the rejection.

Rejection Under 35 U.S.C. § 112, 1st paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, 1st paragraph, for lack of enablement. Applicants respectfully traverse. However, the rejection is rendered moot by the amendments to the claims. Applicants respectfully request withdrawal of the rejection.

Claims 1-12 are rejected under 35 U.S.C. § 112, 1st paragraph, for lack of written description. Specifically, the Office Action indicates that the specification does not contain any disclosure of the function of all of the DNA sequences. However, the rejection is rendered moot by the amendments to the claims. Applicants note that the claimed sequences are capable of

hybridising to the defined set of sequences, which is a function for the claimed DNA sequences. Applicants respectfully request withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102(b)

Claims 1-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Moss et al. (Database Genembl, Accession No. AY054370, submitted 30, August 2001). Applicants respectfully traverse on the basis that the “submitted 30, August 2001” date quoted by the Office Action is not the date of availability of the cited reference for prior art purposes. The sequence data submitted to GenBank was not publicly available as of the submission date. Applicants attach a copy of an email from GenBank stating that the information for accession number AY054370 would be held confidential until December 31, 2006 unless otherwise published. The email states:

You have requested that your data are to be held confidential until:
Dec 31, 2006

They will not be released to the public database until we receive
your permission, or until the data or accession numbers appear in
print, whichever is first.

See attached email from GenBank Direct Submission Staff. The situation with the GenBank submission is the same as that for any peer-reviewed non-patent reference, where the date for prior art purposes is the date of publication of the reference rather than the date of submission of the article for peer review.

The Accession Number reference cited by the Examiner clearly indicates first publication in Mar. Biol. 143, 99-110 (2003). The on-line publication date for the reference was March 29, 2003. Applicants claim priority to GB 02188134, filed August 13, 2002. Therefore, the publication date of the Accession Number is after the claimed priority date, and the rejection

should be withdrawn. Applicants submit herewith a copy of the reference and an IDS citing the reference. Applicants respectfully request withdrawal of the rejection.

Rejection Under 35 U.S.C. § 102(b)

Claims 1 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mabilat et al. (U.S. Patent 5,976,791). The Office Action states that SEQ ID NO:53 of Mabilat displays 66.2% identity of SEQ ID NO:1 of the present application. Applicant's respectfully traverse. However, the rejection is rendered moot by the amendments to the claims. Applicants respectfully request withdrawal of the rejection.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **50-3732**, Order No. 13566.105017.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-3732**, Order No. 13566.105017.

Respectfully submitted,
King & Spalding, LLP

Dated: January 25, 2007

By:


Kenneth H. Sonnenfeld / Michael A. Willis
Reg. No. 33,285 / Reg. No. 53,913

Customer Number 65989
Correspondence Address:
King & Spalding
1185 Avenue of the Americas
New York, NY 10036-4003
(212) 556-2100 Telephone
(212) 556-2222 Facsimile

De: gb-admin@ncbi.nlm.nih.gov [mailto:gb-admin@ncbi.nlm.nih.gov]
Enviado el: jueves, 30 de agosto de 2001 21:29
Para: Velasco Iglesias, Ana; Perez Esteban, Beatriz
Asunto: GenBank AY054370

Dear GenBank Submitter:

Thank you for your direct submission of sequence data to GenBank. We have provided a GenBank accession number for your nucleotide sequence:

METF1 AY054370

We strongly recommend that this GenBank accession number appears in any publication that reports or discusses these data, as it gives the community a unique label with which they may retrieve your data from our on-line servers.

We are now processing your submission and will mail you a copy for your review.

You have requested that your data are to be held confidential until:

Dec 31, 2006

They will not be released to the public database until we receive your permission, or until the data or accession numbers appear in print, whichever is first.

Please send any revisions, including bibliographic information (e.g., conversion from unpublished to published), biological data (e.g., new features), or sequence data to:

gb-admin@ncbi.nlm.nih.gov

You may be interested to know that there are two GenBank submission tools available, BankIt and Sequin. BankIt is available through the World Wide Web (WWW), and Sequin, a stand-alone program, can be downloaded from NCBI's anonymous ftp site. You can access these submission tools through the NCBI Home Page (<http://www.ncbi.nlm.nih.gov/>).

For more information about the submission process or the available submission tools, please contact GenBank User Support at info@ncbi.nlm.nih.gov or at (301) 496-2475.

Respectfully,

Stephen E. Wilhite

The GenBank Direct Submission Staff
Bethesda, Maryland USA